Remarks

Claims 1–6, 8–11, and 14 are pending. All amendments of record have been entered.

Interview of December 15, 2009

The Applicants thank Examiner Lyle A. Alexander for granting the telephonic interview that occurred on December 15, 2009, with their undersigned attorney of record. All claims were discussed in view of all cited art. An agreement was reached that the amendments filed December 4, 2009, would be entered and that a detailed status of the claims would be made of record in a forthcoming advisory action.

The Applicants concur with the Examiner's statements regarding the Interview as set forth in the Advisory Action mailed December 17, 2009. In particular, the Office indicated that the response of December 4, 2009 did not place the present application in a condition for allowance, because to overcome the rejection under 35 U.S.C. § 102(e) over Horn et al. would require submission of a certified English-language translation of the German priority document. However, it was noted that the double patenting rejection would be vacated upon further appeal, in response to the terminal disclaimer filed December 4, 2009. Furthermore, it was noted that all rejections under § 102(b) most likely would be vacated in view of the Applicants' response, as the response was discussed during the interview. Thus, the only outstanding rejection upon further appeal most likely would be the rejection under § 102(e), which may be overcome by the filing of a certified translation of the German priority document.

Rejection Under 35 U.S.C. § 102(e)

Claims 1–11 were rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Horn et al. (U.S. 7,378,255; "Horn").

The Applicants note with appreciation the Examiner's comment in the Advisory Action mailed December 17, 2009, that Horn would not be available as prior art, but only if a certified English-language translation of the German Application No. 103 04 448.5 were provided. As detailed below, it is believed that this requirement has been met and that Horn is not available as prior art.

As set forth in 37 C.F.R. § 1.55(a)(4)(i)(B), an English language translation of a non-English language foreign application submitted as a priority document under 35 U.S.C. § 119(a) is not required except when necessary to overcome the date of an intervening reference relied upon by the examiner. *See also* MPEP 201.15. Contrary to the Applicants' previous assertion that the priority claim of the present application has been perfected already, it has been noted that the filing date of a priority document is in fact *not* perfected unless and until all of the following occur: (1) applicant files a certified priority document; (2) applicant files an English language translation if the document is not in English; and (3) the examiner establishes that the priority document satisfies the written description and enablement requirements of 35 U.S.C. 112, first paragraph. MPEP 706.02(b) [R-6], paragraph (E) under heading "A rejection based on 35 U.S.C. 102(e) can be overcome by:". The Applicants thank the Examiner for bringing to their attention the missing requirements for a perfected priority claim by the present application.

Regarding requirement (1), a certified priority document was filed in the present application on February 4, 2004.

Regarding requirement (2), Applicants have filed with the present response an English language translation of the priority document, German Application No. 103 04 448.5. It is noted that 37 C.F.R. § 1.55(a)(4)(ii) states, "If an English translation [of a priority document] is required, it must be filed together with a statement that the translation of the certified copy is accurate." It is believed that this requirement is satisfied by the statement from Dr. Andreas Blecha attached to the translation.

Regarding requirement (3), it will be evident that the description portions of the translation of the priority document (not including the claims in multiple-dependent format) are substantially identical to the present application as it was filed. Therefore, the Applicants respectfully submit that the priority document satisfies the requirements of 35 U.S.C. § 112, first paragraph.

Thus, with all three requirements now fulfilled, it is believed that the priority claim has been perfected and that the present application is entitled to benefit from the February 4, 2003, filing date of German Application No. 103 04 448.5.

It follows that Horn is not available as prior art against the present application under § 102(e), because Horn was filed in the United States after the effective filing date of the present application. Prior art under 35 U.S.C. § 102(e) is explicitly limited to references "filed in the United States before the invention thereof by the applicant." 35 U.S.C. § 102(e). The applicant may overcome the § 102(e) rejection by proving entitlement to his or her own 35 U.S.C. § 119

priority date that is earlier than the reference's United States filing date. MPEP 2136.03(I) (citing *In re Hilmer*, 359 F.2d 859, 149 USPQ 480 (CCPA 1966).

The present application has a perfected priority claim under 35 U.S.C. § 119(a) to German Application No. 103 04 448.5, filed February 4, 2003. Thus, the effective filing date of the present application is February 4, 2003. Horn was filed in the United States on January 28, 2004, nearly one year after the effective filing date of the present application.

It is believed that the rejection under § 102(e) in view of Horn is overcome. Applicants respectfully request that the Examiner vacate this rejection.

Double Patenting Rejection

Claims 1–11 were rejected on the ground of nonstatutory, obviousness-type double patenting as being unpatentable over claims 1–18 of U.S. Pat. No. 7,378,255 to Horn et al.

The Applicants note with appreciation the Examiner's comment in the Advisory Action mailed December 17, 2009, that this rejection would be vacated upon further appeal, in response to the terminal disclaimer filed December 4, 2009. Therefore, the Applicants respectfully request withdrawal of the double patenting rejection.

Rejections Under 35 U.S.C. § 102(b)

Claims 1–6, 8–11, and 14 were rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Albarella et al. (U.S. Pat. No. 6,872,573; "Albarella"), Hoenes (US 5,334,508), or Ghosh et al. (US 4,358,595, "Ghosh").

The Applicants note with appreciation the Examiner's comments in the Advisory Action mailed December 17, 2009, with respect to the rejections under § 102(b). The Applicants respectfully request reconsideration of the rejections under § 102(b) in view of the arguments submitted in the Applicants' response of December 4, 2009, and further in view of the Interview on December 15, 2009.

Conclusion

It is believed that all rejections have been overcome and that the present application is in a condition for allowance. Applicants respectfully request reconsideration. The Examiner is encouraged to contact the undersigned to resolve efficiently any formal matters or to discuss any aspects of the application or of this response.

Respectfully submitted,

DINSMORE & SHOHL L.L.P.

By /Richard J. McNeely/
Richard J. McNeely
Registration No. 59,149

Fifth Third Center
One South Main Street, Suite 1300
Dayton, Ohio 45402-2023
Telephone: (937) 449-6400
Facsimile: (937) 449-6405
e-mail: richard.mcneely@dinslaw.com